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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/190,727 | 11/12/1998 | CRIS T. PALTENGHE | CITI0080-US | 6980 |

27510 7590 10/10/2002
KILPATRICK STOCKTON LLP
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WASHINGTON, DC 20005

EXAMINER

HAYES, JOHN W

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 10/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/190,727

Applicant(s)

PALTENGHE ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 August 2002 has been entered.

Status of Claims

2. Claims 1-21 were previously canceled and claims 22-26 were previously added. Claim 26 has further been canceled by applicant's preliminary amendment filed 21 December 2000 and claim 25 has been canceled in the amendment filed 20 June 2002. Claims 22-24 remain pending and are again presented for examination.

Response to Arguments

3. Applicant's arguments filed 28 August 2001 have been fully considered but they are not persuasive.

With respect to claims 22-24, applicant asserts that Goldhaber et al fails to disclose or suggest combining the profile data and then anonymizing the combined data. Examiner agrees as this was stated in the previous Office Action. Examiner notes, however, that Goldhaber discloses a database of digitally stored electronic demographic profiles of potential viewers to advertisements and further indicates that many businesses keep profiles of customer interests and transactions by tracking the customers purchases independent of any input from the customer and wherein the profiles are kept private. Goldhaber further discloses that this information is provided to interested merchants who can scan the profiles to determine the merchant's affinity for the customer. Although Goldhaber does not explicitly disclose that the data

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related to a first customer is combined with data related to a second customer, this would have been obvious to one of ordinary skill in the art, especially in view of O'Neil et al. O'Neil et al disclose a system that allows a consumer to protect, command, control and process personal information and teaches combining purchase data with similar purchase data from other consumers to create a list of consumers that may be interested in a certain type of purchase. A very key element of the invention disclosed by O'Neil et al is that a member of the E-Metro community assumes an anonymous electronic identity called an "electronic personal information agent" (E-PIA) (Col. 2, lines 16-22). Therefore, the very process used to join an E-Metro community is anonymizing the data into anonymous data.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims, as currently recited, do not appear to be related to the current title "Distributed Network Based Electronic Wallet".

Drawings

5. The drawings are objected to because of the minor informalities cited on the form PTO 948 forwarded as part of paper number 5.

6. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Goldhaber et al*, U.S. Patent No. 5,794,210 in view of *O'Neil et al*, U.S. Patent No. 5,987,440.

As per claim 22, *Goldhaber et al* disclose a method of transmitting purchase data in a database concerning a first consumer's order to at least one merchant independently of action by the first consumer comprising: storing a first data store made up of data comprising a first consumer's purchase data (Col. 6, lines 24-50); storing a second data store made up of data comprising a second consumer's purchase data (Col. 6, lines 24-50); extracting the first and second consumer's purchase data from the database (Col. 6, lines 24-61), anonymizing the purchase data into anonymous data (Col. 6, lines 27-31; 38-45; Col. 12, lines 46-53) and transmitting the anonymous data to a merchant wherein the anonymizing step is performed independently of any inputs from the consumers (Col. 13, lines 34-55). *Goldhaber et al*, however, fails to specifically disclose that the purchase data is combined with similar purchase data from a second consumer's purchase data. *O'Neil et al* disclose a system that allows a consumer to protect, command, control and process personal information and teaches combining purchase data with similar purchase data from other consumers (Col. 13 line 65-Col. 14 line 14) for the specific purpose of locating members that have expressed an interest in a certain item. It would have been obvious to one skilled in the art at the time of applicant's invention to modify the teachings of *Goldhaber et al* and include the ability to combine purchase behavior or consumer profiles of consumers with similar interests as taught by *O'Neil et al* for the advantage of identifying or locating a group of consumers for which a particular advertisement may be targeted. *Goldhaber et al* provide motivation by indicating that it is well known that advertisers have traditionally attempted to target specific groups or types of consumers based on similar interests since these consumers would be more likely to respond to the advertisement (Col. 1, lines 50-60; Col. 2, lines 22-35; Col. 3, lines 12-24).

As per claim 24, *Goldhaber et al* further disclose wherein the anonymizing is performed with respect to the consumers' identification data (Col. 6, lines 38-45; Col. 7, lines 62-67).

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9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Goldhaber et al*, U.S. Patent No. 5,794,210 and *O'Neil et al*, U.S. Patent No. 5,987,440 as applied to claim 22 above, and further in view of *Low et al*, U.S. Patent No. 5,420,926.

As per claim 23, although it may have been obvious to one skilled in the art to anonymize consumers' purchase data by removing credit card numbers, the combination of *Goldhaber et al* and *O'Neil et al* fail to specifically disclose this feature. *Low et al* discloses a method for conducting anonymous credit card transactions without disclosing the details of the transaction that can be used to identify the consumer. *Low et al* teaches that it is particularly easy to assemble information about a consumer which could be used to invade an individual's privacy. For example, a credit card company or bank can use the information it acquires to determine the spending habits of a customer and can then either use that information in its own business or make it available to others. Thus, it would have been obvious to one skilled in the art to modify the methods of *Goldhaber et al* and *O'Neil et al* and anonymize the purchase data so that consumers' credit card numbers are not disclosed since this is a very effective means to identify the consumer. The specific intent of the teachings of *Goldhaber et al* are to provide consumer purchase data and consumer profile data without specifically identifying any particular consumer, therefore, it would have been obvious to remove information such as credit card numbers in view of the teachings of *Low et al*.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- "Frequent-Shopper Plans Get a Chipper Look", discloses electronically monitoring shoppers purchases with a particular merchant and permit retailers to chart purchasing activity for direct marketing purposes and further teach tracking purchasing behavior and provide merchants with consumer profiles so products can be marketed to specific customers.
- Goodman, John, "Leveraging the Customer Database To Your Competitive Advantage", discloses that customer information can provide marketers with a competitive edge by collecting data from past purchases so that marketing efforts can be tailored to the needs of the customers.

11. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ferguson et al disclose a system and method for secure transaction order management processing and teaches a method wherein consumers can purchase items from multiple merchants and conduct a single checkout
- Peckover discloses intelligent agents used for electronic commerce wherein consumers personal identity is concealed and the agents are used to assist the consumer in comparing and ranking products. Provider personal agents quantify demand and target specific consumers based on preference data without learning their identity.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

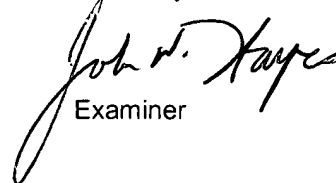
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John Hayes



Examiner

08 October 2002